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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,274	02/05/2001	Jean Paul Marcade	ENDOV-54735	3685
24201	7590	08/23/2005	EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE TENTH FLOOR LOS ANGELES, CA 90045			WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/777,274	MARCADE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 67-72 and 74-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-72 and 74-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 67-72 and 74-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin, US 5,653,743. Because of the similar diameters of the bottom end 6 (column 2, line 63) and the opening 7 and short tube graft 8 (column 2, lines 65-67) and because of the compressible, self-expanding mesh supports (column 2, lines 53-54; column 3, lines 3-5; column 4, lines 15-18; etc.), the extender 18 is certainly *capable* of mating with the longer leg 6, even though such was not the intent. (*Note: the length of the leg 6 as measured from the center of the opening 7 to the bottom end 6 is greater than the length of the leg 8, as seen from the dimensions set forth at column 2, line 65, through column 3, line 3.*) If the extender 18 engages the longer leg 6 after the graft 2 has been placed in vasculature, it is likely that one of the arteries at a bifurcation would be obstructed. However, at the time of the present invention it was known that such a problem could be overcome with bypass surgery, as evidenced by column 2, lines 1-7, of Goicoechea et al., US 5,800,508 (MPEP 2131:01, section III). Although such a procedure clearly has disadvantages, the Martin *structure* nonetheless falls within the scope of the claim language that “the extender [is] configured to mate with the first leg after the body is placed in vasculature” (instant claim 67, last two lines). Regarding claims 70 and 82, in view of the diameter range specified at column 2, lines 61-62, and because of the aforementioned self-expanding mesh supports, the superior end 5 is *capable* of being placed within an aorta of a

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small mammal, with the first leg 6 being placed in an iliac artery, even though such was not the intent.

The Applicant's arguments filed June 3, 2005, have been fully considered but they are not persuasive. The Applicant asserts that "since the Martin patent is concerned with maintaining perfusion to body organs (See column 1, lines 14 et seq.), a person of ordinary skill would not read the Martin patent and conclude that it would be logical to 'obstruct' portions of vasculature as the Examiner suggests" (Applicant's Response of June 3, 2005: page 4, lines 19-22). The Martin '743 teaching, however, encompasses the obstructing of the inferior mesenteric artery if said artery is occluded or "if there is more extensive disease in the aorta" (column 4, lines 30-33). No difference exists between the structure presently claimed (that is, the "body" and its claimed structural features and the "extender" and its claimed structural features) and the Martin '743 bifurcation graft. Moreover, the Martin '743 graft possesses the *capabilities* requisite to meet the terms of the claim (that is, the extender 18 of Martin '743 is *capable* of mating with the longer leg 6), as demonstrated in the grounds of rejection presented above. Therefore, under the inherency doctrine, anticipation exists (*In re Casey*, 152 USPQ 235, 237, and 238 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963); and *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987)). The Goicoechea et al. patent serves as extrinsic evidence (MPEP 2131.01, section III) to show that such a capability would not defeat the intended purpose of "repairing a patient's vasculature" (Applicant's claim 67, line 1).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**